

## **REMARKS**

Claims 1-51 are all the claims pending in the application. Applicants acknowledge that the Examiner has maintained the election of species requirement, and therefore, has withdrawn claims 9-51 from consideration.

By this amendment, Applicants note that claims 1-4, 9-12, 17, 19, 21-24 and 26-29 have been amended in a non-narrowing manner for improved clarity and to improve the general readability of the claims. Such amendments have not been made in response to any prior art or other rejection.

### **I. Election of Species Requirement**

As noted above, the Examiner has maintained the position that the present application contains claims directed to five distinct species. In response to Applicants' argument that Species I-IV, as identified by the Examiner, should be considered a single species, the Examiner has taken the position that the election of species requirement is proper because the claims of Species II-IV would be classified in a different class than the claims of Species I (see Office Action at page 2).

In response, Applicants note that even if the Examiner is correct in asserting that the claims of Species I (i.e., claims 1-8) would be classified in a different class than the claims of Species II-IV (i.e., claims 9-30), the fact the claims of these species may be classified in different classes is not a valid basis for an election of species requirement. If the Examiner maintains the position that species I-IV should not be considered as a single species, Applicants kindly request that the Examiner explicitly point out the section of the MPEP which indicates that claims being classified in different classes is a proper basis for an election of species requirement.

As pointed out in the previous response, MPEP 806.04(f) sets forth the test for determining when a restriction to different species is proper. In particular, this section sets forth that a restriction to different species is proper when "one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first" (emphasis added). This is

frequently expressed by saying that claims to be restricted to different species must recite mutually exclusive characteristics of such species.

In the Office Action, the Examiner has indicated that Figs. 1-7 (claims 1-8) correspond to Species I, that Figs. 8-10 (claims 9-25) correspond to Species II, that Figs. 14-15 (claims 26 and 27) correspond to Species III, and that Fig. 16 (claims 28-30) corresponds to Species IV.

Regarding claim 1, Applicants note that this claim is drawn to a capacitor which recites features such as “a valve metal element for an anode including a capacitor forming part and an electrode lead part”, “a dielectric oxide film provided on a surface of the valve metal element for an anode”, “a solid electrolyte layer provided on the dielectric oxide film” and “a charge collecting element for a cathode provide on the solid electrolyte layer”.

Regarding claim 9, Applicants note that this claim is drawn to a circuit board with a capacitor and recites the same features as recited in claim 1; namely, “a valve metal element for an anode including a capacitor forming part and an electrode lead part”, “a dielectric oxide film provided on a surface of the valve metal element for an anode”, “a solid electrolyte layer provided on the dielectric oxide film” and “a charge collecting element for a cathode provide on the solid electrolyte layer”.

Thus, as is clearly evident from a comparison between claims 1 and 9, all of the limitations recited in claim 1 are also recited in claim 9. Accordingly, Applicants respectfully submit that claim 1 does not recite limitations which under the disclosure are found in the first species but not in the second species. That is, claims 1 and 9 do not recite mutually exclusive characteristics, and therefore, these claims cannot be included in separate species under the criteria set forth in MPEP 806.04(f).

Applicants note that the same analysis with respect to claim 9 also holds for claims 26, 28 and 29. That is, all of the limitations that are recited in claim 1 are also recited in each of these claims. Accordingly, Applicants respectfully submit that Species I-IV should correspond to a single species, and therefore, request that claims 1-30 be examined on the merits.

If the Examiner maintains that the election of species requirement is proper, Applicants kindly request that the Examiner more fully explain the basis for the election of species requirement based on the criteria set forth in MPEP 806.04(f).

## **II. Specification**

Applicants note that a number of editorial amendments have been made to the specification and abstract for grammatical and general readability purposes. In addition, Applicants note that changes have been made to the specification in paragraphs [0185] and [0198] in order to correct typographical errors, each of these changes having support in the priority document which was incorporated by reference into the original specification. Accordingly, no new matter has been added by the above-noted changes.

## **III. Foreign Priority**

Applicants note that the present application claims priority under 35 U.S.C. § 119. The Examiner, however, has not acknowledged the claim for priority or acknowledged receipt of the certified copy of the priority document.

Applicants are enclosing a copy of the Claim for Priority under 35 U.S.C. §, a copy of the declaration, and a copy of the filing receipt, each of which indicates that foreign priority is claimed for the present application. In addition, Applicants are enclosing a copy of the front page of the certified copy of the priority document, and a copy of the stamped postcard from the PTO which indicates that the certified copy of the priority document was received.

In view of the foregoing, Applicants kindly request that the Examiner acknowledge the claim for foreign priority and confirm that the certified copy of the priority document has been received.

## **IV. Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1, 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Shimada et al. (U.S. 6,504,705) in view of Tadanobu et al. (U.S. 6,680,841).

Applicants submit that this rejection is improper because the Tadanobu et al. reference is not considered prior art against the present application based on 35 U.S.C. § 103(c). Applicants note that 35 U.S.C. § 103(c) provides that:

“subject matter developed by another person which qualifies as prior art only under one or more subsections (e), (f) and (g) of §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”(See MPEP 706.02(I)(1)).

Accordingly, this provision, which became effective November 29, 1999 for all applications filed after that date, precludes a commonly assigned patent from being prior art under §102(e)/103.

Applicants submit that the present application and the Tadanobu et al. reference (U.S. 6,680,841), were, at the time the invention of the present application was made, commonly owned by Matsushita Electric Industrial Co., Ltd. Thus, Applicants submit that Tadanobu (U.S. 6,680,841) is disqualified as prior art against the claimed invention pursuant to 35 U.S.C. § 103(c), and therefore, that the above-noted rejection of claims 1, 6 and 7 under 35 U.S.C. § 103(a) should be withdrawn.

In addition, Applicants note that the application which matured in the Tadanobu patent published on February 27, 2003 as US 2003/0039093. This publication, however, is also disqualified as prior art against the present application on the basis of 35 U.S.C. 103(c) and the verified English translation Applicants’ priority document submitted concurrently herewith. In particular, Applicants note that the publication date of February 27, 2003 of US 2003/0039093 is after the application's priority date of December 27, 2002, and therefore, based on the submission of the verified English translation, which perfects the priority date of December 27, 2002, the US 2003/0039093 reference could only qualify as prior art under §102(e)/103.

However, similar to the discussion above, Applicants submit that the present application and the Tadanobu et al. published application (U.S. 2003/003903), were, at the time the invention of the present application was made, commonly owned by Matsushita Electric

Industrial Co., Ltd. Thus, Applicants submit that Tadanobu et al. (U.S. 2003/003903) cannot be used in a rejection under 35 U.S.C. 103(a) based on the above-noted provision of 35 U.S.C. § 103(c).

**V. Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 2-5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

**VI. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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